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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,595	06/18/2001	Ronald E. Pringle	69.0096CIP	1993

7590 06/13/2003

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EXAMINER

DANG, HOANG C

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/883,595

Applicant(s)

PRINGLE ET AL.

Examiner

Hoang Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6 and 9-20 is/are rejected.
- 7) ☒ Claim(s) 3, 4 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on March 31, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on pending second Application Number 09/441,701 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 5, 6, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19 and 20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Longbottom et al (US 6,079,494).

The claimed structure or method steps read exactly on the reference's when plug (56, 56a or 56b) of Longbottom et al '494 is considered as "closure member" or "blocking means" and regulating device (58, 58a or 58b) of Longbottom et al '494 is considered as "sleeve valve" or "choking means" as recited.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Longbottom et al '494 in view of Bouldin et al (US 5,979,558) or Schnatzmeyer (US 5,957,207).

Longbottom et al discloses the invention as claimed except that it is not clear if Longbottom uses a sleeve member having a plurality of ports. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use such a sleeve because it is well known in the art to provide ports on a sliding sleeve of a variable choke or valve to regulate fluid flow as evidenced by Bouldin et al (see column 5, line 37 through column 6, line 5) or Schnatzmeyer (see column 3, line 47 through column 6, line 24).

6. Claims 1, 5, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mashaw, Jr. et al (US 5,211,241) and Mashaw, Jr. et al (US 5,183,114).

Mashaw, Jr. et al '241 discloses a sleeve valve 13 that is selectively positionable at and between an open position and a closed position (see column 1, lines 50-53) to regulate the flow through a second passageway (i.e., upward flow through the tubing). Mashaw, Jr. et al '241 is a continuation-in-part of Mashaw, Jr. et al '114. Mashaw, Jr. et al '114 show the production tubing in which the sliding sleeve valve as disclosed in Mashaw, Jr. et al '241 is mounted includes upper and lower packers 15 to isolate formation fluids. The "first passageway" and "closure member"

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do not distinguish from the annular space between the production tubing 14 and well casing 10 and the upper packer 15 that selectively controls fluid flow through this annular space.

As to claim 11, the "closure member" does not distinguish from the lower packer 15 of Mashaw, Jr. et al. This lower packer 15 controls fluid flow into and herby through the lower end of the tubing 14 from the formation.

As to claim 12, the upper packer 15 constitutes "means for selectively blocking one of the at least two longitudinal passageways" as recited.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mashaw, Jr. et al (US 5,211,241) and Mashaw, Jr. et al (US 5,183,114) as applied to claim 5 above and further in view of Bouldin et al (US 5,979,558) or Schnatzmeyer (US 5,957,207).

The Bouldin et al '558 or Schnatzmeyer '207 reference is applied as above.

#### ***Allowable Subject Matter***

8. Claims 3, 4 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 5, 6 and 9-20 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 703-308-2149. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

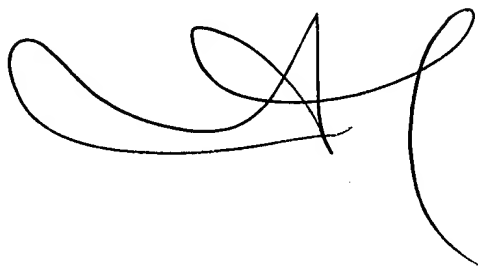
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 703-308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

**Hoang Dang**  
**Primary Examiner**  
**Art Unit 3672**

09883595.2fin  
June 11, 2003

A handwritten signature in black ink, consisting of a series of loops and a long vertical stroke on the right side.